

Remarks

Applicants have canceled claims 1-11 and 14-22 without prejudice or disclaimer. New claims 23-42 have been added in order to claim additional embodiments of the subject matter of the provisionally-elected group. New claims 23-42 find support throughout the specification and claims as originally filed, and thus no new matter has been added.

Originally filed claims 12-13 and new claims 23-42 are pending.

The Restriction Requirement

Pursuant to the Office Action mailed October 3, 2003, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I to IX. The Examiner contends that the inventions of the Groups are distinct, each from the other.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of Group I, directed to polynucleotides encoding SEQ ID NO:3, including but not limited to SEQ ID NO:2 and the cDNA clone contained in plasmid HWHQC55 in ATCC Deposit No. PTA1009.

With respect to the Examiner's restriction of groups directed to a nucleic acid sequence, polypeptides encoded thereby, antibodies recognizing such polypeptides, and methods of using the same, Applicants traverse. As the Examiner has implicitly recognized, even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". See M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups I-IX are separately classified or represent divergent subject matter, Applicants nonetheless submit that, with respect to a given sequence, a search of the claims of the groups directed to that sequence would also provide useful information for the claims of the other groups directed to that sequence. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. Thus, since the searches for proteins, nucleic acids encoding such proteins, antibodies to such proteins, and methods of making and using the same commonly overlap, Applicants respectfully submit that the Examiner's assertion that the

combined search and examination of such compositions and methods using the same would entail a serious burden as to a particular sequence has been rebutted, even assuming *arguendo* that all of the searches were not coextensive.

Accordingly, in view of M.P.E.P. § 803, claims directed to polynucleotides encoding SEQ ID NO:3, the polypeptides encoded thereby, antibodies recognizing such polypeptides, and methods of using the same should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Further, although not acquiescing to the restriction requirement, Applicants nevertheless note that the Examiner has acknowledged that the claims of Group I and the claims of Groups IV and V are related as between a product and processes for making or using the product. *See* page 3. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), if an elected product claim is found allowable, "withdrawn process claims which depend from or otherwise include all of the limitations of the allowable product claim will be rejoined." M.P.E.P. § 821.04. Accordingly, Applicants respectfully request that if any of the claims of Group I, i.e., new claims 23-42, are found allowable, then any process claims of Groups IV and V then pending be rejoined and examined for patentability.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion


Entry of the above amendment is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time

under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

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